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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,076	02/11/2004	Salvatore Cirillo	14324-3US RM/bs	3313

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EXAMINER

HAYES, BRET C

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,076

Applicant(s)

CIRILLO, SALVATORE

Examiner

Bret C Hayes

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 1,3,14,16,17 and 21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

2. Claims 1, 3, 14 and 21 are objected to because of the following informalities.

3. Claims 1, 14 and 21, lines 6, 5 and 10, respectively, it has been held that the recitation that an element is "capable of" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

4. Further, claim 1, line 23, and also claim 3, line 20, it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

5. Claim 3, line 6, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 2, lines 2 and 3, the recitation that “the flexible material covers edges between adjacent walls” is unclear as the base claim recites, *inter alia*, “...at least one wall composed of a flexible material...” (*Emphasis added.*) The examiner’s apparent lack of understanding arises from the at least two walls “consisting of” or “consisting essentially of” the flexible material, to the exclusion of anything else, which material would inherently ‘cover edges between adjacent walls’. (See MPEP 2111.03, Transitional Phrases.) How could the material not cover edges between adjacent walls?

9. Claim 9, line 2, the recitation of “an average size car trunk” is unclear. What dimensions does the average car trunk have? In support of this finding, the disclosure only references “a police car trunk” at [0036], line 8, with no specific reference to its dimensions. Examiner recognizes the intent of the claim, but the metes and bounds are indeterminable.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3644

11. Claims 1, 2, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,454,085 B1 to Barker.

12. Re – claim 1, Barker discloses the claimed invention including a container comprising: a foldable bag 32 having a first open end and at least one wall defining a first enclosure, each of the at least one wall being composed of a flexible material of a constant thickness capable of containing fragments projected by the explosion, as set forth at col. 5, line 30 (5:30); an outer casing 34 having a plurality of first and second panels, as in opposing sides of the container itself, defining a second enclosure for snugly receiving the foldable bag 32, the first and second panels being rigid, the first panels being hingedly connected* to the second panels such that the first panels are movable between a first deployed configuration, where the first panels define a second open end corresponding to the first open end, to a second folded configuration, where the first panels at least partially close the second open end, thereby reducing a height of the outer casing 34; and a first attachment system** on the outer casing 34.

*Most shipping containers of this type have panels, which are hingedly connected in order to fold the containers for shipment in bulk (flat), for example, and to unfold the containers for placing items to be shipped inside.

**In this case, the first attachment system is the top or bottom flaps of the container.

13. Re – claim 2, Barker further discloses the material covering edges between adjacent walls at least partially continuously with the adjacent walls.

14. Re – claim 9, lacking any showing to the contrary, examiner asserts that the device as disclosed by Barker would inherently be capable of being inserted into an average size car trunk when in the folded configuration.

Art Unit: 3644

15. Re – claim 10, Barker discloses the outer casing and foldable bag having a prismatic shape, in that “prismatic” in this sense is taken to mean opposing bases or ends having the same shape, that shape being a parallelogram and a parallelogram being a four-sided plane figure with opposite sides parallel.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 3 – 8, 11, 14, 15, 19, 20 and, alternatively, 10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker.

18. Re – claim 3, Barker discloses the invention substantially as claimed including an inner casing 22, 24, 26, 28 snugly surrounded by the foldable bag 32, see FIG. 2, for example, the inner casing 22, 24, 26, 28 having a plurality of third and fourth panels, the same 22, 24, 26, 28, and the panels being composed of a blast mitigation material, 4:63, except for the third panels being hingedly connected to the fourth panels. Since Barker discloses the outer casing 34 having the same structure as the claimed inner casing, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Barker to substitute the structure of the outer casing for the disclosed inner casing, since doing so would essentially consist of duplicating and rearranging parts of the invention, and, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art [St,

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Regis Paper Co. v. Bemis Co., 193 USPQ 8], and, since it has been held that rearranging parts of an invention involves only routine skill in the art [*In re Japiske*, 86 USPQ 70].

19. Re – claim 4, Barker discloses the claimed invention including the material being “made from a suitable fragment resistant fabric such a woven ballistic cloth,” except for the material being composed of an extended chain polyethylene fabric. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute such a fabric, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

20. Re – claim 5, Barker discloses the claimed invention except for the material being composed of a plurality of layers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of layers, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

21. Re – claim 6, in view of claim 5 above, Barker discloses the claimed invention, including a plurality of walls and at least a portion of the plurality of layers, i.e., “a” layer, being formed by continuous fabric extending in at least a portion of the plurality of walls.

22. Re – claim 7, Barker discloses the claimed invention except for the plurality of layers being disposed to extend perpendicularly to remaining layers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the plurality of layers be disposed to extend perpendicularly to remaining layers, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

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23. Re – claim 8, Barker discloses the claimed invention except for the first and second panels being composed of a rigid foam core sandwiched between two sheets of polyethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first and second panels be composed of a rigid foam core sandwiched between two sheets of polyethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

24. Re – claim 11 and, alternatively, claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement a prismatic shape, since there is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23. See US Patent No. 6,196,107 B1 to Hoffman et al., FIG. 18, for an example of an alternatively shaped containment vessel.

25. Re – claim 14, in view of claims 1 and 5 above, Barker discloses the claimed invention.

26. Re – claim 15, in view of claims 1, 5 and 10 above, Barker discloses the claimed invention.

27. Re – claim 18, in view of claims 1 and 14 above, Barker discloses the claimed invention.

28. Re – claim 19, in view of claims 1 and 4 above, Barker discloses the claimed invention.

29. Re – claim 20, in view of claims 1, 5, 7 and 14 above, Barker discloses the claimed invention.

Allowable Subject Matter

30. Claims 21 and 22 are allowed.

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31. Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

32. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record discloses a container comprising a plurality of walls composed of a material capable of containing fragments projected by an explosion. However, the prior art of record neither discloses nor fairly teaches the recited limitations of the claimed invention including, but not limited to: the material being in the form of first, second and third elongated strips and the strips being disposed to continuously form part of the plurality of layers.

33. This statement is not intended to necessarily state all the reasons for allowance or all the details why the claims are allowed and has not been written to specifically or impliedly state that all the reasons for allowance are set forth (MPEP 1302.14).

Conclusion

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (703) 305 – 7421. The fax number is (703) 872 – 9306.

bh

11/8/04


TERI P. LUU
SUPERVISORY PRIMARY EXAMINER